



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 3724

3724
S.W.
5/Election
1-28-02

In re

Patent Application of

Bednar et al.

Serial No. 09/892,096

Filed: June 26, 2001

Examiner: O. Sanchez

"RECIPROCATING SAW"

I, Patti Brandenburg, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date of my signature.

P Brandenburg
Signature

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This communication responds to the Office action mailed November 6, 2001.

The Examiner has identified in the application the following four inventions:

- I. Claims 1-14 and 23-30, drawn to a reciprocating saw with a drive assembly, classified in Class 30, Subclass 392;
- II. Claims 15-18, drawn to a reciprocating saw with a shoe for movement relative to the housing, classified in Class 30, Subclass 373;
- III. Claims 19-22, drawn to a reciprocating saw with a locking assembly, classified in Class 30, Subclass 377; and
- IV. Claim 31, drawn to a shoe assembly, classified in Class 30, Subclass 375.

The Examiner has required election of one of these inventions.

Applicants contend that the Examiner has improperly required restriction of the application. However, Applicants' attorney elects to prosecute Invention I (Claims 1-14 and 23-30), with traverse, and respectfully requests reconsideration of the restriction requirement.

First, Applicants' attorney respectfully traverses the restriction requirement because there is no serious burden on the Examiner.

In Invention I, independent Claim 1 recites a reciprocating saw comprising a housing, a drive mechanism, a shoe, a shoe support member supporting the shoe, the shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, and a lever for operating the locking assembly. Dependent Claim 10 specifies that the reciprocating saw further comprises a retainer member supported by the housing and defining a channel, and that the shoe support member is movable in the channel. Dependent Claim 14 further specifies that the locking assembly includes a locking member engageable with the shoe support member to lock the shoe support member in a position relative to the housing, the locking member including a first end and a second end, and that the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

Also, independent Claim 23 defines a reciprocating saw comprising a housing, a drive mechanism, a shoe, a shoe support member supporting the shoe, the shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support

member, the locking member having a first end and a second end, and a lever operable to move the locking member, the lever engaging the first end and the second end of the locking member. Dependent Claim 27 specifies that the reciprocating saw further comprises a retainer member supported by the housing and defining a channel, the shoe support member being movable in the channel, and that the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

In addition, independent Claim 28 defines a reciprocating saw comprising a housing, a drive mechanism, a shoe, a shoe support member supporting the shoe, the shoe support member being movably supported by the housing, a locking assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member, the locking member having a first end and a second end, and a lever operable to move the locking member. Dependent Claim 30 specifies that the reciprocating saw further comprises a retainer member, the retainer member defining a first opening and a second opening respectively receiving the first end and the second end of the locking member.

In Invention II, independent Claim 15 defines a reciprocating saw comprising a housing, a drive mechanism, a shoe, a shoe support member supporting the shoe, and a retainer member supported by the housing and defining a channel, the shoe support member being supported in the channel for movement relative to the housing.

In Invention III, dependent Claim 19, which depends from independent Claim 15 of Invention II, specifies that the reciprocating saw further comprises a locking

assembly operable to lock the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member to lock the shoe support member in a position relative to the housing, the locking member including a first end and a second end, and that the retainer member defines a first opening and a second opening respectively receiving the first end and the second end of the locking member.

In Invention IV, independent Claim 31 defines a shoe assembly for a reciprocating saw, the shoe assembly comprising a shoe, a shoe support member supporting the shoe, a retainer member supported by the housing and defining a channel, the shoe support member being movably supported in the channel and movable relative to the housing, a locking assembly for locking the shoe support member in a position relative to the housing, the locking assembly including a locking member engageable with the shoe support member, the locking member having a first end and a second end, and a lever operable to move the locking member.

The reciprocating saw of Inventions I, II and III and the shoe assembly for a reciprocating saw of Invention IV are so inextricably related to one another that the inventions should be examined in a single application. A complete and thorough search of the prior art for the reciprocating saw of Inventions I, II, or III or for the shoe assembly of Invention IV would require a search of the subject matter of the others.

Therefore, there is not a serious burden on the Examiner. The inventions have the same classification, status in the art, and field of search. MPEP §803.01.

The Examiner has stated that the claims of Invention I are in Class 30, Subclass 392; that the claims of Invention II are classified in Class 30, Subclass 373; that the claims of Invention III are classified in Class 30, Subclass 377; and that the claims of Invention IV are classified in Class 30, Subclass 375. Applicants respectfully submit, however, that the claims of all of the inventions are more properly classified in Class 30, Subclass 377, which relates to cutting tools and, more particularly, to saws with a work-engaging member including a relatively adjustable saw blade and guide plate to vary the projection of the saw blade.

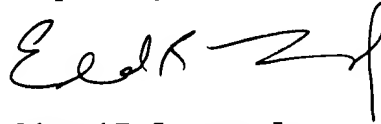
As discussed above, the claims of each of the inventions generally relate to a movable shoe for a reciprocating saw. Specifically, in Invention I, the reciprocating saw includes a shoe for engaging a workpiece, and a shoe support member supporting the shoe, the shoe support member being movably supported by the housing. In Inventions II and III, the reciprocating saw includes a shoe for engaging a surface of a workpiece, and a shoe support member supporting the shoe, the shoe support member being supported for movement relative to the housing. In Invention IV, the shoe assembly for a reciprocating saw includes a shoe for engaging a surface of the workpiece, and a shoe support member supporting the shoe, the shoe support member being supported and movable relative to the housing of the reciprocating saw. Therefore, the claims of each of the inventions are properly classified in Class 30, Subclass 377.

Assuming arguendo that the inventions defined by the claims have acquired a separate status in the art, it is respectfully submitted that there will not be a serious burden placed on the Examiner if restriction is not required. MPEP §§ 803, 808.02.

Practicality and efficiency and the lack of serious burden on the Examiner dictate that the claims should be retained and the restriction requirement should be withdrawn. The restriction requirement, if sustained, will prejudice Applicants because of the increased cost to the Applicants arising from further substantial filing fees and prosecution costs.

In view of the foregoing, withdrawal of the restriction requirement and, in the alternative, consideration of Claims 1-14 and 23-30 of elected Invention I on the merits are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ed R. Lawson, Jr.', with a stylized flourish at the end.

Edward R. Lawson, Jr.
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File No. 066042/9223 01

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